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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Andrew Mackenzie

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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

KASSA, HILINA S

ART UNIT

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2625

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/677,863	Applicant(s) MACKENZIE ET AL.	
	Examiner Hilina S. Kassa	Art Unit 2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

1. Figure 3 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 10-11 recite "**a print job**" which does not impart a machine, a manufacture, a process or a composition of matter.

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4. Claims 12-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 12-14 recite "**a program code**" which does not impart functionality to a computer or computing device, and is thus considered nonfunctional descriptive material. Such nonfunctional descriptive material, in the absence of a functional interrelationship with a computer, does not constitute a statutory process, machine, manufacture or composition of matter and is thus non-statutory per se. While "functional descriptive material" may be claimed as a statutory product (i.e., a "manufacture") when embodied on a tangible computer readable medium.

5. Claims 15-16 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows.

Claims 15-16 recite "**a printed instruction sheet**" which does not impart a machine, a manufacture, a process or a composition of matter.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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7. Claims 10-16 and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Moritani (US Patent Number 6,415,115 B1).

(1) regarding claim 12:

Moritani discloses a program code instructions for controlling a print system (20, figure 1; interface control), said program code instructions comprising:

a component for generating a user instructions (column 5, lines 25-26), said user instructions specifying an orientation for entering a set of media sheets into an input tray of a printer device (column 5, lines 31-34; note that the printing table is considered as the instruction); and

a component for automatically activating printing of said user instructions along with printing of said media sheets (column 5, lines 34-37; note that the image information gets printer according to the received instruction information).

(2) regarding claim 13:

Moritani further discloses the program code as claimed in claim 12, configured so as to print said user instructions on a separate sheet of media which is additional to a set of media sheets used for printing of a document (column 5, lines 21-27).

(3) regarding claim 14:

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Moritani further discloses the program code instructions as claimed in claim 12, operable for printing said user instructions on a same media sheet as used for printing a document sent for printing (column 6, line 60-column 7, line3).

(4) regarding claim 15:

Moritani further discloses a printed instruction sheet containing a set of instructions advising a human user on orientation of a stack of print media, for entering said stack of print media into an input tray of a printer device (column 3, lines 35-41).

(5) regarding claim 16:

Moritani further discloses an electronic print job data comprising data for printing an instruction sheet as claimed in claim 15 (column 5, lines 21-37).

(6) regarding claim 19:

Moritani further discloses a method for printing two sided documents (column 2, lines 46-50), said method comprising:

formatting a plurality of document pages in a form suitable for printing on a plurality of sheets of print media (column 3, lines 8-15);

printing first sides of said plurality of sheet media with said document (column 5, lines 44-48); printing instructions for handling of said plurality of sheets of media (column 6, lines 16-22);

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manipulating said plurality of sheets of media in accordance with said set of printed instructions (column 5, lines 21-27);

placing said set of media sheets into an input tray of a printer device (column 5, lines 33-34); and

printing second sides of said plurality of media sheets with said document (column 5, lines 49-51).

(7) regarding claim 20:

Moritani further discloses a method of sending a print job for double sided printing on a printer device (column 2, lines 46-50), said method comprising:

sending an DUPLEX ON instruction signal to said printer device (column 6, lines 40-43), indicating a duplex printing mode (column 6, lines 40-43; note that the double-side printing mode gets set); sending a user instruction for instructing a user to manipulate at least one media sheet at said printer device (column 7, lines 4-8; note that printing gets performed in the fed sheets); and

sending a document file to said printer device for printing (column 6, lines 40-43; note that the print job gets printed).

(8) regarding claim 21:

Moritani further discloses a method of printing a received print job for double sided printing of a document on a printer device (column 2, lines 46-50), said method comprising:

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receiving a document file at said printer device (column 1, lines 47-49),
said document file comprising a set of consecutive pages (column 5, lines 38-43);

receiving a DUPLEX ON instruction signal at said printer device (column 6, lines 40-43), instructing said printer device to adopt an interrupted printing mode for printing said a document (column 3, lines 3-7; note that the sequential process is considered as the change of mode from single to double-side printing);

in response to said DUPLEX ON instruction printing a first set of pages of said document on first sides of said media sheets (column 5, lines 44-48);

receiving a user instruction for instructing a user to manipulate at least one media sheet at said printer device (column 5, lines 21-27);

printing said user instructions on at least one media sheet (column 6, lines 60-66); and

printing a second set of pages of said document on second sides of said media sheets (column 5, lines 49-51), said second set of sides being alternating with said first set of sides (column 5, lines 37-43).

8. Claims 10-11 and 17-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Maniwa et al. (US Patent Number 5,731,879).

(1) regarding claim 10:

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Maniwa et al. disclose a print job comprising: a plurality of pages of information arranged in a data format comprising a plurality of first sides and a plurality of second sides (column 11, lines 15-22; note that there are plurality of pages); and

a user information data, describing instructions to a human user for orientation of a set of media sheets for entry into a printer device (column 12, lines 17-25).

(2) regarding claim 11:

Maniwa et al. further discloses the print job as claimed in claim 10, further comprising a pause command for pausing printing of said media sheets after a print operation of a set of first sides of said media sheets (column 2, lines 52-58; note that print job is stopped when the number of sheets exceed the allowable sheets stocked in tray).

(3) regarding claim 17:

Maniwa et al. further disclose a printing system operable for:
printing first sides of a set of print media sheets (column 12, lines 44-45);
and
printing a set of instructions for entering said set of printed print media sheets into a printer device for printing second sides of said media sheets (column 12, lines 58-66).

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(4) regarding claim 18:

Maniwa et al. further disclose the printing system as claimed in claim 17, further operable for:

printing said second sides of said plurality of print media sheets in response to a signal activated by a human user (column 12, lines 58-66).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maniwa et al. (US Patent Number 5,731,879) and further in view of Moritani (US Patent Number 6,415,115 B1).

(1) regarding claim 1:

As shown in figures 1-9 Maniwa et al. disclose a method of printing double sided documents on a printer device (column 2, lines 32-39; note that images are printed on duplex surface of each form), said method comprising:

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printing at least one first side of at least one media sheet in a single operation (column 11, lines 8-9; note that an image is formed on one surface of printing paper);

instructing a user to introduce said at least one media sheet into said printer device (column 11, lines 10-22; note that paper is fed from a paper feed tray by a drum); and

printing at least one second side of said at least one media sheet (column 11, lines 22-25; note that image is printed on one surface of printing paper).

Maniwa et al. disclose all of the subject matter as described as above except for printing a set of user instructions.

However, Moritani teaches printing a set of user instructions (column 5, lines 21-27; note that the instructions from a user terminal gets printed).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to print a set of user instructions.

The suggestion/motivation for doing so would have been that it would be easier to organize and to have a reliable device.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 1.

(2) regarding claim 2:

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Maniwa et al. further disclose a method of printing double sided documents on a printer device (column 2, lines 32-39), said method comprising: formatting said document into a form suitable for printing onto first sides of a plurality of media sheets in a single operation (column 5, lines 18-22; note that the print data gets converted to PDL in order to make it suitable for printing); generating a set of user instructions for instructing a human user to manipulate said plurality of media sheets and enter said sheets into said printer device (column 11, lines 10-22; lines 40-45); and

Maniwa et al. disclose all of the subject matter as described as above except for printing a set of user instructions.

However, Moritani teaches printing a set of user instructions (column 5, lines 21-27; note that the instructions from a user terminal gets printed).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to print a set of user instructions.

The suggestion/motivation for doing so would have been that it would be easier to organize and to have a reliable device.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 2.

(3) regarding claim 3:

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Maniwa et al. further disclose the method as claimed in claim 2, further comprising:

formatting said document into a form suitable for printing onto a set of second sides of said plurality of media sheets (column 5, lines 18-22; note that the print data gets converted to PDL in order to make it suitable for printing even if the page is in the first side or second side); and

printing said document onto said set of second sides of said plurality of media sheets (column 11, lines 27-28).

(4) regarding claim 4:

Maniwa et al. further disclose the method as claimed in claim 2, comprising:

printing said document onto a set of second sides of said plurality of media sheets (column 11, lines 27-28); and

Maniwa et al. disclose all of the subject matter as described as above except for teaching to activate said printing of said second sides in response to a user command input via a user interface of said printer device.

However, Moritani teaches to activate said printing of said second sides in response to a user command input via a user interface of said printer device (column 5, lines 23-27; note that the interface controls the status of the input header).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to activate said printing of said second sides in response to a user command input via a user interface of said printer device.

The suggestion/motivation for doing so would have been that it would be efficient.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 4.

(5) regarding claim 5:

Maniwa et al. further disclose the method as claimed in claim 2, comprising: printing said document onto a set of second sides of said plurality of media sheets (column 11, lines 27-28); and

Maniwa et al. disclose all of the subject matter as described as above except for to activate printing of said set of second sides in response to an activation signal input via a user interface at a computer entity.

However, Moritani teaches to activate printing of said set of second sides in response to an activation signal input via a user interface at a computer entity (column 1, lines 29-36; note that a computer device or a terminal device is used to prepare a document with a single or double-side printing pages).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

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At the time of the invention, it would have been obvious to a person of ordinary skill in the art to activate printing of said set of second sides in response to an activation signal input via a user interface at a computer entity.

The suggestion/motivation for doing so would have been that it would be efficient enough for user to modify changes at user's computer terminal than the printer.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 5.

(6) regarding claim 6:

Maniwa et al. further disclose a printing system comprising:

a computer entity capable of generating a print job (column 3, line 59-column 4, line 18);

a printer device for printing a plurality of sheets of print media according to said print job (column 12, lines 46-57);

said printing system operable for: printing first sides of a set of said print media sheets (column 12, lines 44-45); and

entering said set of printed print media sheets into said printer device for printing second sides of said media sheets (column 12, lines 58-66).

Maniwa et al. disclose all of the subject matter as described as above except for printing a set of user instructions.

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However, Moritani teaches printing a set of user instructions (column 5, lines 21-27; note that the instructions from a user terminal gets printed).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to print a set of user instructions.

The suggestion/motivation for doing so would have been that it would be easier to organize and to have a reliable device.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 6.

(7) regarding claim 7:

Maniwa et al. further disclose the printing system as claimed in claim 6, further operable for: printing said second sides of said plurality of print media sheets in response to a signal input by a human user (column 12, lines 58-66).

(8) regarding claim 8:

Maniwa et al. further disclose the printing system as claimed in claim 6, further operable for:

printing said second sides of said plurality of print media sheets in response to a signal input by a human user (column 12, lines 58-66).

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Maniwa et al. disclose all of the subject matter as described above except for teaching wherein said input signal is input via a graphical user interface.

However, Moritani teaches wherein said input signal is input via a graphical user interface (column 3, lines 48-50; note that the image forming apparatus comprises an interface for transmitting/receiving an operation control signal).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art wherein said input signal is input via a graphical user interface.

The suggestion/motivation for doing so would have been that it would be for effectively control the selections.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 8.

(9) regarding claim 9:

Maniwa et al. further discloses the printing system as claimed in claim 6, further operable for:

printing said second sides of said plurality of print media sheets in response to a signal input by a human user (column 12, lines 58-66).

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Maniwa et al. disclose all of the subject matter as described above except for teaching wherein said input signal is received via a printer user interface positioned on said printer device.

However, Moritani discloses an image forming apparatus wherein said input signal is received via a printer user interface positioned on said printer device (column 3, lines 47-53).

Maniwa et al. and Moritani are combinable because they are from the same field of endeavor.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art wherein said input signal is received via a printer user interface positioned on said printer device.

The suggestion/motivation for doing so would have been that it would be for effectively control the printing device.

Therefore, it would have been obvious to combine Maniwa et al. with Moritani to obtain the invention as specified in claim 9.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barrett et al. (US Patent Number 6,239,880 B1) discloses a method for processing a job including image data and a set of attributes in a document processing system.

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Hernandez (US Patent Number 6,650,428 B1) discloses a method and apparatus using duplex print to print indicia on the back side of a printed page to provide privacy for confidential information.

Minter (US Patent Number 4,903,139) discloses image generating system for duplex printing.

Tanaka et al. (US Patent Number 5,095,371) disclose a duplex image forming system with number of single side printed sheets in feed path selected before printing second side.

12. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Hilina Kassa whose telephone number is (571) 270-1676.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Twyler Lamb could be reached at (571) 272- 7406.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks

Washington, D.C. 20231

Or faxed to:

(703) 872-9314 (for Technology Center 2600 only)


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Hilina Kassa

July 30, 2007



TWYLER LAMB
SUPERVISORY PATENT EXAMINER